

## **R E M A R K S**

### **A. INTRODUCTION**

Claims 1, 63-72, 75 and 76 are pending and rejected.

Upon entry of this Amendment:

- Claims 1, 63-72, 75 and 76-81 will be pending
- Claims 1, 75 and 76 will be amended
- Claims 77-81 will be added
- Claims 1, 75 and 76 will be the only independent claims

### **B. NON-STATUTORY DOUBLE PATENTING REJECTION**

Claim 1 stands “rejected under the judicially created doctrine of obviousness-type double patenting” as being unpatentable over specified claims of U.S. Patent No. 6,694,300.

While Applicants do not necessarily agree with this rejection, a terminal disclaimer is filed concurrently herewith solely to expedite the prosecution of the present application. Accordingly, the non-statutory double patenting rejection of Claim 1 is moot.

### **C. SECTION 103(A) REJECTIONS**

Claims 1, 63, 75 and 76 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Roach (U.S. Patent No. 5,434,394) and further in view of Deaton (U.S. Patent No. 5,621,812). Applicants respectfully traverse the Examiner’s Section 103(a) rejection.

Claims 64-74 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Roach (U.S. Patent No. 5,434,394) and further in view of Deaton (U.S. Patent No. 5,621,812) and Humble (U.S. Patent No. 4,825,045).

Independent Claims 1, 75 and 76 each recite a feature generally directed to: *determining, by a central controller, an upsell from a second merchant to offer to the customer based on the at least one purchase parameter, the upsell having associated therewith an upsell price* (emphasis added). Applicants respectfully submit that neither Roach nor Deaton teaches an upsell from a second merchant, as recited in the independent claims, much less an upsell from a second merchant that is not the first merchant, as recited in each of independent Claims 75 and 76. To the contrary, Roach is directed to products and services offered by a retail location and does not hint at offering products or services of other merchants. Similarly, Deaton is explicitly directed to generating coupons and incentives for a grocery

store. Accordingly, there is no hint of any upsell from a second merchant. The Office Action does not establish a prima facie case of obviousness based on Roach and/or Deaton for at least the reason that the cited references do not support the alleged factual finding. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the Section 103(a) rejections of Claims 1, 63-72, 75 and 76.

Further, solely in order to expedite allowance of the present Application and not for any reason related to patentability, Applicants have amended independent Claim 1 to recite a feature of wherein the method is performed by a party that is not the first merchant and is not the second merchant. Applicants respectfully submit that neither Roach, Deaton nor Humble teach such a feature. Applicants also note the Notices of Allowance mailed April 1, 2002, and May 13, 2002, in ancestor application no. 08/994426, in which Examiner James Myhre acknowledged that no prior art (including the Roach reference) could be found that disclosed certain claimed activities being performed by an entity distinct from the first and second merchants.

Further, solely in order to expedite allowance of the present Application and not for any reason related to patentability, Applicants have amended independent Claim 75 to recite a feature of wherein the central controller is not owned or controlled by the first merchant or by the second merchant. Applicants respectfully submit that, as they are directed to supplemental sales offered by a merchant for use with the merchant, neither Roach nor Deaton teaches such a feature.

Further, solely in order to expedite allowance of the present Application and not for any reason related to patentability, Applicants have amended independent Claim 76 to recite a feature of wherein the apparatus is not the first merchant and is not the second merchant. Applicants respectfully submit that, as they are directed to supplemental sales offered by a merchant for use with the merchant, neither Roach nor Deaton teaches such a feature.

For at least these reasons, Applicants respectfully request the Examiner's reconsideration and withdrawal of the Section 103(a) rejections of Claims 1, 63-76, 75 and 76, and allowance of the present Application.

#### **D. ADDITIONAL COMMENTS**

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of

the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

**E. NEWLY-ADDED CLAIMS 77-81 ARE PATENTABLE OVER THE CITED REFERENCES**

Newly-added Claims 77-81 are patentable over the cited Roach, Deaton and Humble references for at least the reasons presented herein. No new matter has been added.

The cited references, alone or in combination, do not teach all of the features of independent Claim 1, as discussed above.

Independent Claim 1 recites a feature of performing the comparison and but does not specify when the step is performed relative to any other steps. Claim 81 recites a particular embodiment in which the step of performing the comparison is performed before transmitting the product identifier for specifying the upsell.

For at least the reasons stated herein, we respectfully submit that new Claims 77-81 contain allowable subject matter.

**F. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES**

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Deposit Account: 50-0271

Order No.: 97-007-C1

Please credit any overpayment to the same account.

**G. CONCLUSION**

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 438-6408 or via electronic mail at [mtdowns@finchamdowns.com](mailto:mtdowns@finchamdowns.com).

Respectfully submitted,

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Date

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